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Joseph Harbaugh

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EXAMINER

CASLER, TRACI

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/826,690	<b>Applicant(s)</b> HARBAUGH, JOSEPH	
	<b>Examiner</b> Traci L. Casler	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 23-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

This action is in response to papers filed on August 10, 2009.

Claims 23-56 are pending.

Claims 23-56 are rejected.

#### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 23-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. As to claims 23-56 in order for a method/process claim to fall within statutory subject matter the claims must be tied to either a machine or transformation. A two-branched inquiry is used to show that a claims is statutory by either tying it to a particular machine or a by showing that the claim transforms an article. The use of a specific machine or transformation of an article must impose "meaningful limits" on the claims' scope to impart patent-eligibility. The involvement of the machine or transformation in the claimed process must not merely be **insignificant extra-solution activity, such as storing, gathering, displaying, sending and receiving of data** as this does not impart a significant impact in the solution to the process. See in re Bilski.

4. In Claims 23-56 the claims are drawn to a method. For purposes of 101, a "process" has been given a specialized, limited meaning by the courts. Based on In re Bilski (Federal Circuit 2007-1130), the court outlined a test used to determine whether a method satisfies 35 USC 101, is a machine-or-transformation test. In re Bilski states

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"the machine-or- transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies 101 **either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.** See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra- solution activity. See Flook, 437 US at 590.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 23-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over New York Times article, "Opponents of Change in CUNY Admissions Policy Helped Pass a Compromise Plan., Nov. 24, 199, Arenson, Karen; Hereinafter referred to as CUNY in view of official notice and [www..gradcollege.stw.edu](http://www.gradcollege.stw.edu) retrieved from the archive.org any linkage February 29, 2000.

7. As to claims 23, 43- 44 and 56 CUNY teaches offering a program for admissions to the graduate school that includes an abbreviated academic program(Pg. 2 ¶ 8).

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Subjecting test takers to a test during the examination .program(PG. 2 ¶ 7) Admitting student to the graduate program who achieve a satisfactory score(Pg. 2 ¶ 8).

8. CUNY fails to teach calibrated grading and identifying the students who have not applied to the school. Calibrated Grading is an old and well known process of grading examination to promote fairness as noted by applicants affidavits submitted August 24, 2005, therefore it would have been obvious to use such a well known system when testing individuals against each other.

9. As to the limitation getting a pool of standardized test takers the examiner takes official notice that it is old and well known in the art of admissions to purchase or gain access to a list of students in a particular category in order to target enrollment.

The examiner draws on her experience as an admissions counselor from August 1999 to May 2004 that colleges and universities routinely purchase student names and test scores from testing organizations such as SAT in order identify students in an academic/testing category in which the school wishes to target enrollment. This practice was taking place long before the examiner was in the field in 1999. Therefore it would have been obvious to use a test taking pool batch for identifying new admits targeted for enrollment. The examiner notes the reference [www.collegeboard.com](http://www.collegeboard.com) was made of record as getting standardized test takers in response to applicants traversal of the official notice.

10. CUNY fails to teach the method being applied to a grad school versus an undergraduate program. Grad college teaches a conditional admission process for a graduate school. It would have been obvious to one skilled in the art at the time of

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invention to combine Grad college with CUNY as success in one level of education would warrant a one to try this approach in a different level.

11. As to the limitation of correlating a score with academic success the examiner notes the "academic success" in which the scores are correlated to are non-functional descriptive material, For example the "final grades" are never positively recited as being collected for comparison, therefore, the type of test used in determine the student's skill does not produce a function in the method, the function is based off the score of the test not the exact test itself, therefore any pre-determined score/achievement meets the limitation.

12. As to claim 24 CUNY teaches remedial courses without credit(Pg. 2 ¶ 9). 11.

13. As to claim 25 CUNY teaches a predetermined test score(Pg. 2 ¶ 79). Although, CUNY fails to teach the test score that is correlated to academic success the examiner notes it would have been obvious to one of skill in the art to use any type of scoring that would demonstrate the student's ability to be successful.

14. As to claim 26-27, 45-46 and 51 CUNY teaches an abbreviated program(Pg. 2 ¶ 7). The examiner note the specific duration of the program is non-functional descriptive material. As the duration of the program is not used in any further determination for the program. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless-of the duration of the program. "Thus; this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re

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Gulack, 703 F.2d 1381, 1385, 217 USPQ 401,44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

15. As to claim 28-29, 47 and 50 Grad college teaches the GRE verbal and written. (Pg. 7 l. 10- 14). It would have been obvious to one skilled in the art to combine Grad college with CUNY as there are different levels of standardized testing for the specific levels of schooling.

16. As to claims 31-36 and 48-49 CUNY teaches instructing the students. As to the method of which the student is taught, either synchronous, asynchronous and online or in-person are non-functional descriptive material. These differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The steps would be performed regardless of the type of instruction being provided.. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381 ,. 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

17. As to claim 37 CUNY teaches an abbreviated academic program, however CUNY does not teach a program for Law School. It would have been obvious to combine CUNY with law school. If one sees success in one area of education it would be obvious to try the same method at a different level with reasonable expectations of success and predicable results. See Supreme Court Decision KSR.

18. As to claims 30, 38-41 and 52-54 CUNY teaches a method for admitting students who do not have the grades and test scores for regular admissions. CUNY

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fails to teach a shifting range for test scores and GPA's. Grad College teaches a shifting system based on GRE and GPA(Pg. 7 I. 5-25). It would have been obvious to one skilled in the art to combine Grad College with CUNY so as to find a balance for students who test well but average grades or don't test well and have great grades. The examiner also notes that applicant has stated in the specification Pg. 13 I. 1-10 that shifting ranges are old and well known in the admissions field.

19. As to 42 and 55 CUNY teaches a method for admitting students who do not have the grades and test scores for regular admissions but fails to teach a calibrated grading system. However, the calibrated grading system is old and well known to those in the arena of examination grading.

### ***Response to Arguments***

20. Applicant's arguments filed August 10, 2009 have been fully considered but they are not persuasive.

21. Applicants first arguments are directed to the rejection of claims 23-56 under 35 USC 101 as not being statutory subject matter. The applicant argues there is "absolutely no analysis" supporting the conclusion and points to section MPEP 706.3(a) where it states that a proper reject should state.... The examiner notes that ¶ 3 states the reasoning and analysis, however the rejection has been elaborated on in order to simplify the rejection for the applicant. The applicant further argues that because the claimed invention is not directed to the mentioned "legal obligations or relationships, business risks or other such abstractions" it does not fall within the "narrow" scope of the Bilski decision. However, the examiner notes that "other such abstractions"

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encompassed all methods/processes to fall under scrutiny under the decision. The applicant cited an excerpt from Bilski Pg. 23 l. 1-6 which support the examiners rejection the sections states "Purported transformations or manipulations of simply public or private legal obligations or relationships, business risks or other such abstractions cannot meet the test because they are **NOT PHYSICAL OBJECTS OR SUBSTANCES**", this statement contradicts applicants argument that transformation of "data", which is no a physical object, does not meet the requirements of statutory test taker. The applicant further argues that the claimed method requires a computer however, applicant does not positively claim the computer as performing/imparting limitations of the claimed invention such as directed to the solution attempting to be solved. The applicants passively claims the identifying, being "enabled by a computer product" however, this could simply be either the identified test takers being sent to the institution or the user simply reviewing a list of names on a computer screen or a user simply selecting criteria to be used to identify, ie which grade or test scores to use.

22. The applicant has submitted arguments once again affidavits as evidence of non-obviousness of the references and affidavits by the inventor with arguments drawn towards commercial success, long-felt need and unexpected results.

23. Applicant's affidavit first addresses unexpected results, stating that the "claimed invention" produced unexpected results of having students with lower LSAT scores perform successfully in law school and this being an unexpected result. Applicant's results are not truly unexpected. Applicant developed the claimed invention with the intention to admit students with lower test scores believing they would perform better

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than their test scores indicated. Applicant went into with this "hypothesis" theory based on the fact that studies have shown students with lower test scores will out perform than those with higher scores. (As disclosed in affidavit submitted by Philip Shelton on August 24, 2005) See also applicants affidavit Pg. 3 4th paragraph. Therefore the results were exactly what the applicant was expecting to obtain. Applicant is directed to MPEP 716.02 for Allegations of Unexpected results and Evidence must show unexpected result. Applicant has no "control" group from which to base the allegations that because of the "claimed" method is what created the results. Applicant would have had to have students admitted on a regular basis with the same academic criteria as that of the "claimed" invention to be able to state the invention is the reason for success. There is no evidence to show that ONLY lower performing students would be successful with the additional services provided by the program. The examiner asserts for these results to be truly unexpected it would have to be show that other students admitted to the program who had the necessary criteria for regular admission would not have performed successfully in the program. It is not uncommon knowledge, in the education field, that when students are given additional support and guidance they will perform at a great rate.

24. As to applicant's arguments that the claimed invention has distinguished itself as a commercial success, the examiner first reviews what is deemed commercial success when using sales figures as discussed in the MPEP 716.03 IV.

Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (Bd. Pat. App. & Inter. 1988).

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25. Applicant states that "numerous" law schools began licensing the claimed invention as early as 2001 and has generated \$285,000 in revenue without any type of advertising. But when one takes in to account all factors involved \$285,000 over 7 years does not necessarily demonstrate commercial success. According to an affidavit submitted by Richard A Matasar, Dean of New York Law School, who has been licensing the claimed invention since 2004 they pay \$35,000 a year for the program and to date has spent \$175,000, more than half of the generated revenue claimed for the entire seven years. Even if the cost was a one time fee of \$35,000 that would mean only 8 schools have licensed the claimed invention out of the hundreds of law schools in the US, Which is not a statistically significant number.

26. Lastly, the applicant argues long-felt need citing the US Supreme court involving the University of Michigan's Law school admissions program. The examiner again reviews what constitutes long-felt need according to the MPEP 716.04.

Establishing long-felt need requires objective evidence that an art recognized problem existed in the art for a long period of time without solution. The relevance of long-felt need and the failure of others to the issue of obviousness depends on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539, 152 USPQ 602, 605 (CCPA 1967) ("Since the alleged problem in this case was first recognized by appellants, and others apparently have not yet become aware of its existence, it goes without saying that there could not possibly be any evidence of either a long felt need in the . . . art for a solution to a problem of dubious existence or failure of others skilled in the art who unsuccessfully attempted to solve a problem of which they were not aware."); *Orthopedic Equipment Co., Inc. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 217 USPQ 1281 (Fed. Cir. 1983) (Although the claimed invention achieved the desirable result of reducing inventories, there was no evidence of any prior unsuccessful attempts to do so.).

Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988) (Although at one time there was a long-felt need for a "do-it-yourself" window shade material which was adjustable without the use of tools, a prior art product fulfilled the

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need by using a scored plastic material which could be torn. "[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved".)

Third, the invention must in fact satisfy the long-felt need. *In re Cavanagh*, 436 F.2d 491, 168 USPQ 466 (CCPA 1971).

27. The examiner first notes that this portion of the applicant's affidavit is directed towards establishing "cultural diversity" in a university. As "cultural diversity" is not any part of the claimed limitations technically this part of the affidavit is moot as it is not directed to the claimed language. However, for sake of advancing prosecution the examiner will address applicant's belief of solving an unmet long felt need.

28. The examiner points to the fact that long felt need can only be established when the problem existed without solution. Therefore, the fact that UMLS has had a policy in place that diversified their law school admissions since at least 1996, when the petitioner in the case Grutter, was denied admission, clearly states that the need had/has been met to establish a "culturally" diverse school demographic.

29. As to applicants statements that the examiner has failed to present the applicant with a reference in response to the official notice request. The examiner indicates that a reference was supplied in the action May 22, 2008 action in which the examiner Supplied a [www.collegeboard.com](http://www.collegeboard.com) for identifying a pool of students within any desired demographic. The applicant argues the reference is and/or use of official notice does not disclose the limitation as claimed. The limitation as claimed is broad in it's interpretation...who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school. The examiner states that the criteria are for "a graduate school" not "the graduate school" or a specific graduate school. The identifying is simply a pool of test takers within an identified range/target. The exact

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scores or GPA's do not create a function in the claimed method. The steps will be performed the same regardless of the identified/targeted users. The method identifies a pool of students and offers them a program for admission. The applicant has failed to show how their claimed step of identifying is different based on the target.

30. As to applicants arguments that one would not be motivated to use "undergraduate" admissions policies in a graduate program the examiner notes that the applicant is simply making allegations and has not brought forward evidence to dispute or support why one would not use a method already being applied in one area of education that has proved successful to another area of education. Applicant argues that an affidavit submitted by Philip D. Shelton CEO of Law school admissions counsel that he doesn't know of any other school that request names "clearly outside fo the range of those acceptable to the requesting graduate school or graduate schools in general". This statement is narrower than the claimed limitation is insufficient to gain admission to a law school, therefore the scores could be insufficient to gain admission to Harvard law school but still within "acceptable" range for NOVA law school. The examiner further notes just because someone has not done it to Mr. Shelton's knowledge does not mean it is not obvious to select students according to a targeted group of students for enrollment.

31. The examiner notes that applicant's arguments are addressing the references individually against a 103 rejection. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

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*Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

32. As to the affidavit submitted by Richard Matasar as to the success of students admitted in the "claimed" invention fails to point out what aspect of the invention is the "novel" aspect which makes the method a success. From Mr. Matasar's affidavit and the information provided one could derive that the students GPA is an indicator of success in school as the differences in the GPA's were not different. Additionally, with only having 37 students total admitted to thru the program and of those 37 students only 5 students have graduated. The low numbers of students involved are not statistically significant to make any type of derivations or assumptions. The sample size being used does not adequately provide relevant information especially according to how many students are being admitted into the regular admissions process.

### ***Conclusion***

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Casler whose telephone number is 571-272-6809. The examiner can normally be reached on Monday, Tue-Friday 7:00 am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/  
Examiner, Art Unit 3629